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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/683,907	02/28/2002	Mark Brian West		9244

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EXAMINER

VAUGHAN, MICHAEL R

ART UNIT	PAPER NUMBER
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2131

DATE MAILED: 07/22/2004

6

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/683,907

Applicant(s)

WEST, MARK BRIAN

Examiner

Michael R Vaughan

Art Unit

2131

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☒ Claim(s) 1-9 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 February 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claims 1-9 have been examined and are pending.

Drawings

Formal drawings are required in response to the instant Office action.

Figure 1a, 2a, 3a, and 5a-7 should be designated by a legend such as --Prior Art- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

Claim 6 is objected to because of the following informalities: it is dependent from claim 1 but refers to limitations in claim 4. For purposes of examination. Examiner is interpreting claim 6 to be dependent from claim 4.

Claim 5 is objected to because it contains two sentences. Claims can only be one sentence. Appropriate correction is required.

Claims 7-9 are objected to because the certificate authority is referenced by the initials "CA". If applicant wishes to do so, the claims should be consistent and in claim 6 should have "(CA)" beside certificate authority.

Claim Rejections - 35 USC ' 101 Utility

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1 and 2 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The language of the claims 1 and 2 raises a

question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment, or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 USC 101. It is unclear from the language of the claims whether the method could be followed by hand or if a computer-device would be needed to implement the method.

Claim Rejections - 35 USC ' 112, second paragraph

Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitations "the positive identification" and "the party". There are insufficient antecedent basis for this limitation in the claim.

Claim 2 recites the limitation "the authenticity". There is insufficient antecedent basis for this limitation in the claim.

Claim 4 recites the limitations "the requester" and "the certificate authority". There is insufficient antecedent basis for this limitation in the claim.

Claim 9 recites the limitation "the format". There is insufficient antecedent basis for this limitation in the claim.

The lack of antecedent basis can usually be overcome by substituting the word – a—for the word "the". Clarification and/or correction are required.

Regarding claim 5, the phrase "such generic elements as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Regarding claim 5, there is no support in the specification for a retinal scan or DNA sequence, which is defined in the claim. All features of the claims must be disclosed in the specification. However, no new matter can be added to the specification. There is also no basis of support for the generic elements listed in claim 5.

Claim Rejections - 35 USC ' 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Musgrave et al, hereinafter Musgrave (USP 6,202,151).

As per claim 1, Musgrave teaches a Method of securely binding a digital representation of biometric data to a digital certificate in such a manner as to facilitate the positive identification of the party to whom the digital certificate was issued (see Figure 2).

As per claim 2, Musgrave teaches a method of validating the authenticity of certificate bound biometric data at the time of performing other certificate validation processes (column 3, lines 55-60).

As per claim 3, Musgrave teaches a digital certificate is issued to a person, entity, or device (column 3, lines 34-35). This claim is the in alternative, therefore only one entity must be taught to meet the limitation of this claim.

As per claim 4, Musgrave teaches biometric data of the requester is submitted to the certificate authority in such a manner as to positively associate the biometric data with a matching certificate request (column 3, lines 49-50).

As per claim 5, Musgrave teaches the biometric data submitted may be any form or combination of digital data which represents a biological characteristic or combination of biological characteristics of such capacity as to uniquely identify a physical person (column 4, lines 30-53).

As per claim 6, Musgrave teaches the biometric data submitted is embedded into a certificate prior to the signing of the certificate by a certificate authority (see Figure 3).

As per claim 7, Musgrave teaches the certificate created and signed by the CA is a digital certificate as defined by any standard (column 1, line 65—column 2, line 14).

As per claim 8, Musgrave teaches the certificate created and signed by the CA contains biometric data that may be extracted and validated by applications specifically designed to do so (column 6, lines 5-12).

As per claim 9, Musgrave teaches the biometric data embedded into the certificate created and signed by the CA does not cause the format of the certificate to deviate from the standard by which the certificate was defined, and does not render the

certificate in any way invalid or unusable by any application which may use the certificate as input and which fully supports the standard by which the certificate was defined (column 2, lines 29-31).

Remarks

An examination of this application reveals that applicant is unfamiliar with patent prosecution procedure. While an inventor may prosecute the application, lack of skill in this field usually acts as a liability in affording the maximum protection for the invention disclosed. Applicant is advised to secure the services of a registered patent attorney or agent to prosecute the application, since the value of a patent is largely dependent upon skilled preparation and prosecution. The Office cannot aid in selecting an attorney or agent.

Applicant is advised of the availability of the publication "Attorneys and Agents Registered to Practice Before the U.S. Patent and Trademark Office." This publication is for sale by the Superintendent of Documents, U.S. Government Printing Office, Washington, D.C. 20402.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael R Vaughan whose telephone number is 703-305-0354. The examiner can normally be reached on M-F 7:30-4:00.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 703-305-9648. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MV
Michael R Vaughan

Examiner

Art Unit 2131


AYAZ SHEIKH
SUPERVISORY PATENT EXAMINER
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